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10/590,963	08/29/2006	Masahito Suzuki	2244.0470000/TGD/JHH	5641
26111 7590 12/29/2009 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
JOY, DAVID J				
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1794				
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12/29/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/590,963

## Applicant(s)

SUZUKI ET AL.

## Examiner

David J. Joy

## Art Unit

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-16 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2006 and 08 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/29/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election **without** traverse of Group I, Claims 2-9, in the reply filed on October 13, 2009 is acknowledged.
2. Claims 10-16 and 20-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 13, 2009.

### *Priority*

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Drawings*

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because, for example, in Fig. 2 reference characters "3" and "5" have both been used to designate the lowest layer in the multilayer arrangement (when taking the layers from the top down). This is just one example of a problematic drawing in the instant application.

Given the sheer number of drawings that were originally filed, Examiner admits that there may be other instances that warrant Applicant's attention. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### *Claim Rejections - 35 USC § 112*

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2-5 are indefinite due to the fact that it is unclear how the component layers are configured individually and how those components interconnect with each other. The word usage (e.g., does the cylindrical label comprise a label substrate, and is that label substrate a separate layer from those other layers recited therein?) and grammar employed renders the claims rather indefinite. It is suggested that Applicant first clearly define the component layers, then how the components structurally interact with each other to form the cylindrical label, and then, once the label is constructed, delineate the outstanding aspects and/or features that warrant attention.

8. Claims 6-9 are rejected accordingly, as they all depend upon Claim 4.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 2-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U.S. Patent of Yoshida et al. (4,983,238; hereinafter “Yoshida”) in view of the Japanese Patent Application Publication of Shibazaki (2001-125489) or the Japanese Patent Application Publication of Kashiwa (2003-335343). For the purposes of this Office Action, all citations to Shibazaki and Kashiwa shall be made to the machine translations of those references (which are attached hereto).

12. Yoshida teaches a heat-shrinkable cylindrical label that contains an inner layer sheet (“foam polystyrene sheet”), a design printed layer (“printed pattern”), and an

outer layer sheet ("film of polystyrene and an olefin resin") (see Abstract; see also Column 2, Line 66 – Column 3, Line 6). Yoshida also teaches that the inner layer sheet and the outer layer sheet are laminated together, and that the ends of the label are adhered to one another by an adhesive or solvent (see Column 2, Line 66 – Column 3, Line 19). However, it is noted that Yoshida fails to expressly recite the presence of an adhesive layer in the composite label.

13. Shibazaki, which is drawn to a label for a container, expressly provides that when the component layers of the label (i.e., a heat-shrinkable outer layer, a foamed resin layer, and a printing layer) are laminated to one another, it is conventional, for example, to laminate the layers using adhesives (see ¶ [0014]). Also, as previously discussed, Yoshida discloses a label having the same constituent layers as the presently-claimed invention. Shibazaki also teaches that the layers can be arranged in varying order when composing the container label.

14. However, Yoshida and Shibazaki fail to expressly teach the order of layers that are instantly claimed. Nevertheless, it would have been obvious to a person having ordinary skill in the art at the time of invention to rearrange the position of the component layers of the heat-shrinkable label, because the ends of the composite label, in any of the arrangements, will still be able to be secured to one another, and, in turn, the wrapped label will be able to be affixed to a cylindrical container/substrate, as

taught by the references cited *supra*, thereby achieving its intended function as a heat-shrinkable cylindrical label. It has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). *See also, In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). *See also, MPEP* §2144.04.

15. Yoshida teaches that inner layer sheet comprises a foamed resin sheet which can be a polystyrene resin, a styrene-butadiene resin, a maleic anhydride resin or a methacrylic acid resin (see Column 4, Lines 7-9). Likewise, Shibazaki teaches that the while the inner layer sheet can be made of the same foamed resins taught by Yoshida, the inner layer sheet can also be a cloth or a nonwoven fabric, where the fabric contains synthetic fibers (see ¶ [0022]). As Yoshida and Shibazaki are drawn to the same field of invention, it would have been obvious to a person having ordinary skill in the art at the time of invention to make the heat-shrinkable label taught by Yoshida, and to incorporate the features that are taught by Shibazaki, thereby arriving at the presently-claimed invention.

16. Yoshida teaches a heat-shrinkable cylindrical label, as discussed hereinabove. In addition, it is clear from those teachings that the heat-shrinkable cylindrical label will



necessarily have a container-contacting face, as the reference expressly teaches that the label is to be formed into a cylinder and wrapped around a container (see Column 3, Lines 9-19).

17. Yoshida, though, fails to teach or suggest that there is a heat-sensitive adhesive coated on the container-contacting face. Kashiwa, which is drawn to a cylindrical label and a container bearing the cylindrical label, teaches that there is an adhesive that is contained on a contact place of the cylindrical label (see ¶ [0009]). Additionally, Kashiwa teaches that once the cylindrical label is applied to the container, steam is applied to the cylindrical label, thereby establishing that the adhesive can be deemed to be a heat-sensitive adhesive. As both Yoshida and Kashiwa are drawn to the same field of invention, it would have been obvious to a person having ordinary skill in the art at the time of invention to make the heat-shrinkable label taught by Yoshida, and to incorporate that which is taught by Kashiwa, thereby arriving at the presently-claimed invention.

### *Conclusion*

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056. The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

20. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on (571) 272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

22. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Ruthkosky/  
Supervisory Patent Examiner, Art Unit 1794

/DJJ/  
Examiner, Art Unit 1794  
12/11/2009